

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) RHB 8982.4							
I hereby certify that this correspondence is being delivered by the United States Postal Service with sufficient postage to deliver it in all jurisdictions addressed to Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 ^{being filed via EFS} April 13, 2007 on _____ Signature <u><i>Cindy A. Ard</i></u> Typed or printed name <u>Cindy A. Ard</u>		<table border="1" style="width: 100%; border-collapse: collapse;"> <tr> <td style="padding: 5px;">Application Number 10/814,683</td> <td style="padding: 5px;">Filed 03/31/2004</td> </tr> <tr> <td colspan="2" style="padding: 5px;">First Named Inventor James N. Rothbarth et al.</td> </tr> <tr> <td style="padding: 5px;">Art Unit 2163</td> <td style="padding: 5px;">Examiner Helene Rose</td> </tr> </table>		Application Number 10/814,683	Filed 03/31/2004	First Named Inventor James N. Rothbarth et al.		Art Unit 2163	Examiner Helene Rose
Application Number 10/814,683	Filed 03/31/2004								
First Named Inventor James N. Rothbarth et al.									
Art Unit 2163	Examiner Helene Rose								
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <table style="width: 100%;"> <tr> <td style="width: 50%; vertical-align: top;"> <input type="checkbox"/> applicant/inventor. <input type="checkbox"/> assignee of record of the entire interest. (See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/95)) <input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>27,416</u> <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____ </td> <td style="width: 50%; vertical-align: top; text-align: center;"> <u>/Frank R. Agovino/</u> _____ Signature Frank R. Agovino _____ Typed or printed name 314-231-5400 _____ Telephone number April 13, 2007 _____ Date </td> </tr> </table> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.</p>				<input type="checkbox"/> applicant/inventor. <input type="checkbox"/> assignee of record of the entire interest. (See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/95)) <input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>27,416</u> <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____	<u>/Frank R. Agovino/</u> _____ Signature Frank R. Agovino _____ Typed or printed name 314-231-5400 _____ Telephone number April 13, 2007 _____ Date				
<input type="checkbox"/> applicant/inventor. <input type="checkbox"/> assignee of record of the entire interest. (See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/95)) <input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>27,416</u> <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____	<u>/Frank R. Agovino/</u> _____ Signature Frank R. Agovino _____ Typed or printed name 314-231-5400 _____ Telephone number April 13, 2007 _____ Date								
<input checked="" type="checkbox"/> Total of <u>1</u> forms are submitted.									

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of James N. Rothbarth et al.

Art Unit 2163

Serial No. 10/814,683

Filed March 31, 2004

Confirmation No. 8322

For METHOD AND SYSTEM FOR SHARING STORAGE SPACE ON A
COMPUTER

Examiner Helene Roberta Rose

April 13, 2007

PRE-APPEAL BRIEF CONFERENCE REQUEST FOR REVIEW

Applicants hereby request review of the Office's rejection of claims 1-14 as set forth in the final Office action dated December 14, 2006 and the advisory action dated March 29, 2007.

Applicants submit that the rejections of record are clearly not proper and are without basis, and request a panel decision that eliminates the need to file an appeal brief. This request is based upon a clear factual deficiency in the rejection rather than an interpretation of the claims or prior art teachings.

SUMMARY OF ARGUMENTS

Applicants will point out that the Examiner has:

- (1) failed to identify in the prior art the presence of "selectively transferring ... via a communications network or via a portable computer readable medium ... based on a target amount," an essential step recited by claims 1-14 and required to establish a prima facie rejection;
- (2) failed to identify in the prior art the presence of "physically delivering a portable computer readable medium ... when the files are greater than a target amount," an essential physical step recited by claims 13-14 and required to establish a prima facie rejection;
- (3) failed to identify in the prior art the presence of "the originating user determining the target amount," an essential step recited by claim 14 and required to establish a prima facie rejection.

SUMMARY OF THE INVENTION

The method facilitates the transfer of back-up copies of one or more files from a first computer to a second computer. The user defines a target amount (claim 14). If

the first computer files to be backed up are less than the target amount, the files are backed up by transfer to the second computer "via a communications network." If the first computer files to be backed up are greater than the target amount, the files are backed up by transfer to "a portable computer readable medium." The portable computer readable medium (CRM) is then physically delivered (claim 13) to the second computer and the files are transferred from the portable CRM to the second computer. Thus, a large file backup which could take hours to transfer via a communications network can be accomplished via physical transfer via a portable CRM.

(1) The prior art does not include selectively transferring via a communications network when the files are less than a target amount or via a portable computer readable medium when the files are greater than a target amount, an essential step recited by claims 1-14.

Claims 1-14 stand rejected under 35 U.S.C. 103 (a) as being obvious over U.S. Patent No. 5,659,614 to Bailey, III (Bailey) in view of U.S. Patent No. 6,049,874 to McClain et al. (McClain). Claim 1 recites:

selectively transferring, based on a total size of the files being transferred, the designated files and file data from the first computer to the second computer or to a portable computer readable medium;

wherein the designated files and file data are transferred to the second computer at the identified location **via a communication network** when a total size of the files being transferred is **less than a target amount**, and wherein the designated files and file data are transferred from the first computer to the **portable computer readable medium** when the total size of the files being transferred is **greater than the target amount**;

The Examiner cites column 9/lines 23-30 of Bailey as teaching **selectively transferring**:

sector. The discarding of the changes in the CDA is performed because the changes to the sector are large (consuming over one half the number of bytes in the sector) and thus it is more efficient to transmit the entire sector rather than the many changes within the sector. The goal of using the method described in the flow chart of FIG. 4 is to store only relatively small changes in the CDA, while large changes are not stored in the CDA. The entire sector in which large changes occur, as identified by the HCS table value of "1" for that sector, will be transmitted to the backup site.

The Examiner cites column 11/lines 35-41 of Bailey as teaching a **target amount**:

and places that file in the transmission file. The transmission 35
file is a file of finite size determined by the channel capacity
analysis of step 502 such that less than all the files to be
transmitted may fit within the transmission file. When
backup transmissions are desired, the contents of the trans-
mission file are transmitted to the backup site. Only files 40
within the transmission file are transmitted to the backup
site. Thus, when the transmission file is full, no other files

However, these portions of Bailey do not selectively transfer via either a
communications network OR via a portable computer readable medium (CRM) to a
second computer, depending on a target file size. Instead, Bailey does sector analysis
to decide **whether or not** to transfer a file, if it fits "within the transmission file."

In this regard, the examiner also points to McClain, from column 3, line 63 to
column 4, line 4:

In preferred embodiments, the method steps yet further include
periodically copying remote versions of file blocks at the data center onto a
portable data storage medium. Local files are restored by copying remote
versions of the file blocks from the portable data storage medium when the
remote versions that are stored on the portable data storage medium are at least
as current as the remote versions stored at the data center, and otherwise they
are restored by copying remote versions of the file blocks from the data center.

However, McClain teaches using a portable CRM to restore files to the same computer,
not to selectively transfer from the first computer to the second computer, depending on
the target amount.¹

Claim 13 includes substantially the same recital.² Thus, the Examiner has failed
to identify in the prior art the presence of "selectively transferring...via a communications
network or via a portable computer readable medium...based on a target amount," an
essential step recited by claims 1-14 and required to establish a prima facie rejection.
The rejection of claims 1-14 should be reversed.

¹ In the Advisory Action, the Examiner cites McClain at column 3, lines 15-20, and concludes that remote
delivery is equivalent to delivering via a portable CRM. In the Advisory Action, the Examiner cites McClain at
column 6, lines 39-48, and concludes that modem 26 is equivalent to a portable medium.

² Claim 13 recites: "transferring the files from the verified first computer to a portable computer readable
medium; selectively delivering the portable computer readable medium to a user of the destination computer based
on an amount of data in the one or more files to be transferred, wherein the portable computer readable medium is
physically delivered to the destination user when the amount of data to be transferred is greater than or equal to a
target amount, and wherein the one or more files are transferred from the first computer to the second computer via a
communication network when the amount of data to be transferred is less than the target amount."

(2) The prior art does not teach "physically delivering a portable computer readable medium ...when the files are greater than a target amount," an essential physical step recited by claims 13-14.

Claim 13 recites a method including, among other things:

selectively delivering the portable computer readable medium to a user of the destination computer based on an amount of data in the one or more files to be transferred, wherein **the portable computer readable medium is physically delivered** to the destination user when the amount of data to be transferred is greater than or equal to a target amount, and wherein the one or more **files are transferred** from the first computer to the second computer **via a communication network** when the amount of data to be transferred is less than the target amount. (emphasis added).

Thus, claim 13 recites a method including backup file transfer **via a communication network AND via physical delivery of a portable computer readable medium**, i.e., two different types of transfer are recited based on target amount.

The Examiner has pointed to the following as making this recital obvious (pages 11-12 of final Office action):

selectively delivering the portable computer readable medium to a user of the destination computer based on an amount of data in the one or more files to be transferred (Refer to claim 1, wherein this limitation is substantially the same/or similar), wherein the portable computer readable medium is physically delivered to the destination user when the amount of data to be transferred is greater than or equal to a target amount (Refer to claim 1, wherein this limitation is substantially the same/or similar), and wherein the one or more files are transferred from the first computer to the second computer via communication network when the amount of data to be transferred is less than the target amount (Refer to claim 1, wherein this limitation is substantially the same/or similar, Bailey).

However, the **physical delivery** recital is not recited in the method of claim 1 so that the Office action does not address this aspect of the method of claim 13.³ In any case, both Bailey and McClain *only* disclose electronic backups via a network. Neither reference mentions **PHYSICAL DELIVERY** via a portable medium when the files exceed the target amount in addition to backups via a communications network. Thus, the Examiner has failed to identify in the prior art the presence of "physically delivering a

³ In the Advisory action, the Examiner argues that the data center of McClain "is interpreted to be a centralized storage facility which is interpreted to be equivalent to 'physical structure' and wherein the 'chunks is transmitted to the data center' is interpreted to be 'physically delivered'." However, claim 13 recites that the portable CRM, not the files, are physically delivered.

portable computer readable medium...when the files are greater than a target amount," an essential physical step recited by claims 13-14 and required to establish a prima facie rejection. The rejection of claims 13-14 should be reversed.

(3) The prior art does not teach "the originating user determining the target amount," an essential step recited by claim 14.

Claim 14 further recites that "the originating user determines the target amount." The Examiner cites the following (page 12 of the final Office action):

Regarding claim 14, the combination of Bailey in view of McClain teaches wherein the originating user determines the target amount (column 11, lines 35-38, wherein finite size is interpreted to be limited or restricted in nature, Bailey).

However, column 11, lines 35-38 of Bailey are as follows:

and places that file in the transmission file. The transmission file is a file of finite size determined by the channel capacity analysis of step 502 such that less than all the files to be transmitted may fit within the transmission file.

This section of Bailey does not indicate that the transfer amount is determined by the originating user, as recited by claim 14. Instead, it says that the finite size is determined by channel capacity analysis. McClain does not address this.⁴

Further, claim 14 recites that the originating user determines whether files are transferred via a communication network OR physically via a portable medium, based on their size. Bailey and McClain only teach electronic transfer via a network based on channel capacity. Thus, the Examiner has failed to identify in the prior art the presence of "the originating user determining the target amount," an essential step recited by claim 14 and required to establish a prima facie rejection. The rejection of claim 14 should be reversed.

Respectfully submitted,

/Frank R. Agovino/

Frank R. Agovino, Reg. No. 27,416
SENNIGER POWERS
One Metropolitan Square, 16th Floor
St. Louis, Missouri 63102
(314) 231-5400

⁴ In the Advisory Action, the Examiner cites McClain at column 3, lines 53-55, and concludes that transfer chunks equals a predetermined size.